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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,965	06/20/2001	George Wai-Kin Chan	P50800	3090

20462 7590 05/06/2003

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EXAMINER

ZUCKER, PAUL A

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 05/06/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/720,965

Applicant(s)

CHAN ET AL

Examiner

Paul A. Zucker

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20 is/are allowed.
- 6) ☒ Claim(s) 11,12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 27 January 2003 was filed after the mailing date of the Final Office Action on 11 February 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. The previous indication of allowability set forth in paragraph 12 of the previous Office Action in Paper No 11 is withdrawn based upon the new rejections below.

### ***Current Status***

2. The finality of the previous Office Action in Paper No 11 is withdrawn.
3. This action is responsive to Applicants' amendment of 14 April 2003 in Paper No 13.
4. Receipt and entry of Applicants' amendment is acknowledged.
5. Claims 11-20 remain outstanding.
6. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 11 of the previous Office Action in Paper No 11 is withdrawn in view of Applicants' amendment.

### ***Claim Rejections - 35 USC § 102***

7. Claims 11, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al (Analyst 1985,110, pages 603-604). Bailey discloses (Page 603, bottom, Table 1, 3<sup>rd</sup> entry and column 2, last full paragraph) the terbium chelate of the compound derived from DTPA and aminobenzophenone-COOH. Thus instant claims 11, 12 and 14-16 are anticipated by Bailey.

Art Unit: 1621

8. Claims 11, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ozaki et al (CAS, Accession Number:127:77478/DN, Kidorui, 30, 1997, pages 358-359). Ozaki discloses (Abstract) the compound derived from p-aminobenzophenone and DTPA and its europium chelate. This compound is a compound of formula I in which the R1 has the structure ABP and n=1. Thus instant claims 11, 12 and 14-16 anticipated by Ozaki.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sinn et al (US 6,410,695 B1 06-2002). Sinn discloses (Figure 2) the compound Celliton blue-DTPA. This compound is a compound of formula I in which the R1 has the structure AAQ and n=1. Thus instant claims 11, 12 and 14 are anticipated by Sinn.

### ***Claim Objections***

10. Claims 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

11. Claims 11-20 are pending. Claims 11, 12 and 14-16 are rejected. Claim 13 is objected to. Claims 17-20 are allowed.

Art Unit: 1621

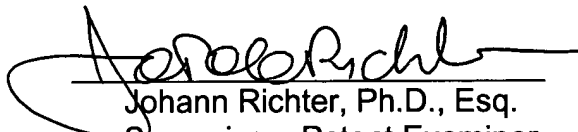
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker  
Patent Examiner  
Technology Center 1600

May 2, 2003

  
Johann Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Technology Center 1600